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PATENT
Customer No. 22,852
Attorney Docket No. 06502.0301

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
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Venkata S. AYYAGARI et al.) Group Art Unit: 2144
)
Application No.: 09/593,742) Examiner: Thanh T. NGUYEN
)
Filed: June 14, 2000)
)
For: A METHOD FOR CACHING XML)
DOCUMENTS VIEWABLE ON)
DEVICES WITH DIFFERENT)
DISPLAYS)

RECEIVED

JUN 25 2004

Technology Center 2100

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY TO OFFICE ACTION

In reply to the Office Action mailed April 5, 2004, the period for reply extending to July 5, 2004, please reconsider the above-identified application in light of the following remarks.

Claims 1-3, 6-8, 10-12, and 19 are pending in this application. In the Office Action mailed April 5, 2004, the Examiner indicated at paragraph 2 that claims 1-3, 6-8, 10-12, and 19 were examined. However, the rejection in paragraph 4 states that claims 1, 2, 6, 7, 10, 11, and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Crosskey et al. (U.S. Patent No. 6,035,281) in view of Huang et al. (U.S. Patent No. 6,292,835) and further in view of Shen et al. (U.S. Patent No. 6,401,059). Because the Examiner has included claims 3, 8, and 12 in the rejection (pages 4, 6, and 7),

Applicants believe the Examiner inadvertently omitted claims 3, 8, and 8 from the rejection in paragraph 4. Should Applicants' understanding be incorrect, Applicants respectfully request the Examiner to so clarify in the next Office communication.

Applicants respectfully traverse the rejection of claims 1-3, 6-8, 10-12, and 19 under 35 U.S.C. § 103(a) as being unpatentable over Crosskey in view of Huang and further in view of Shen.

To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8th ed. 2001). Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02 (8th ed. 2001). Moreover, each of these requirements must be found in the prior art, not in applicant's disclosure. See M.P.E.P. § 2143 (8th ed. 2001).

Applicants' claim 1 recites a combination of steps including, among other things, "determining whether the document is an unprocessed extensible markup language (XML) document; when it is determined that the document is an unprocessed XML document, determining whether a processed version of the document is located in a local cache; when it is determined that the processed version of the document is located in the local cache, providing the processed version of the document to the client."

Crosskey, Huang, and Shen, whether taken alone or in combination, do not disclose or suggest at least these features.

The Examiner admits in the Office Action (page 3) that Crosskey does not teach “when it is determined that the processed version of the document is not located in the local cache, (i) obtaining the unprocessed document associated with the content provider; (ii) processing the unprocessed document in accordance with predetermined instructions associated with the unprocessed document; and (iii) providing the processed version of the identified processed document to the client,” as recited in claim 1. The Examiner then alleges Huang makes up for some of the deficiencies of Crosskey. See Office Action, page 3.

Applicants respectfully disagree with the Examiner’s allegations. Huang discloses a proxy strategy that caches objects and actively sets update schedules for channel information disseminated from different servers. Based on available bandwidth, the proxy strategy formulates a mathematical function that can be solved to establish the proxy update schedules by maximizing the overall currency of information received by the clients. See Abstract. In other words, Huang discloses determining when to update cache data based upon available bandwidth. See col. 3, lines 23-25. These teachings, however, do not constitute “when it is determined that the processed version of the document is not located in the local cache, (i) obtaining the unprocessed document associated with the content provider; (ii) processing the unprocessed document in accordance with predetermined instructions associated with the unprocessed document; and (iii) providing the processed version of the identified processed document to the client,” as recited in claim 1.

Moreover, the Examiner alleges that there is motivation to combine Crosskey and Huang because it would be “useful to have a series of actions, changes, or functions bringing about a result” (Office Action, page 3). This alleged motivation does not appear to have any basis in either Crosskey or Huang. More importantly, the Examiner’s alleged motivation has no bearing on the claim elements alleged by the Examiner to be found in Huang. The rejection of claim 1 under 35 U.S.C. § 103(a) is thus improper for at least these reasons.

The Examiner also admits in the Office Action (page 3) that Crosskey and Huang do not teach determining whether the document is an unprocessed extensible markup language (XML) document, and determining that the document is an unprocessed XML document. The Examiner then alleges Shen makes up for these deficiencies of Crosskey and Huang, alleging one of ordinary skill in the art would have combined the teachings of these three references because the result would be “an efficient system that can provide specific functions to settle or decide (a dispute, question, etc.) by an authoritative or conclusive decision” (Office Action, page 4). Applicants respectfully submit that such an allegation has no basis in the references. Such an allegation by the Examiner is unsubstantiated by any factual evidence in the record, such as a competent prior art reference. Nor does such an allegation have any bearing on the claim elements at issue. For at least these additional reasons, a *prima facie* case of obviousness has not been made and the Examiner should withdraw the rejection of claim 1.

Notwithstanding the Examiner’s unsubstantiated allegation of motivation to combine, Applicants nevertheless respectfully submit that there is no motivation to

combine the teachings of Crosskey, Huang, and Shen. Crosskey discloses a system and method for billing for Internet access. Huang discloses determining when to update cache data based upon available bandwidth. Shen discloses updating television program schedule information in a database. See col. 3, lines 55-57. Nothing in these three references with such divergent teachings suggests any desirability of making the Examiner's proposed combination. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." M.P.E.P. § 2143.01, p. 2100-124, *citing In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Accordingly, Applicants submit that Crosskey, Huang, and Shen, taken alone or in combination, do not suggest the desirability of any modification to result in Applicants' claimed invention, and these references do not show that there would be any reasonable expectation of success from so doing. Because Crosskey, Huang, and Shen, alone or in combination fail to teach or suggest all of the recitations of claim 1, Applicants request that the Examiner withdraw the rejection of the claim under 35 U.S.C. § 103(a) for at least the above reasons.

Independent claims 6, 10, and 19 include recitations similar to those of claim 1. As set forth above, claim 1 is allowable over Crosskey, Huang, and Shen. Accordingly, claims 6, 10, and 19 are also allowable over these references. The Examiner should thus withdraw the rejection of these claims for at least the same reasons discussed above in connection with allowable claim 1.

Regarding claims 3, 8, and 12, the Examiner states that Crosskey and Huang do not teach the invention as claimed, wherein the predetermined instructions associated

with the unprocessed document are stored in a stylesheet associated with the content provider. The Examiner also cites col. 4, lines 58-67. See Office Action at pages 4, 6, and 7. However, the Examiner does not identify to which reference this citation is in relation. Moreover, none of the applied prior art references (Crosskey, Huang, and Shen) disclose or suggest that "the predetermined instructions associated with the unprocessed document are stored in a stylesheet associated with the content provider," at col. 4, lines 58-67. In fact, this citation appears to have no bearing whatsoever on the claim element at issue with respect to any of the applied prior art references. The rejection of claims 3, 8, and 12 is therefore improper for at least this reason. Moreover, claims 3, 8, and 12 are also allowable due to at least their dependencies from allowable claim 1. Applicants respectfully request that the Examiner withdraw the rejection.

Claims 2, 7, and 11 depend from one of claims 1, 6, and 10, respectively. Because claims 1, 6, and 10 are allowable over Huang, Crosskey, and Shen, the Examiner should thus withdraw the rejection of claims 2, 7, and 11 under 35 U.S.C. § 103(a) for at least the reasons discussed above.

CONCLUSION

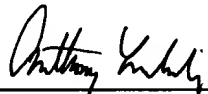
In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: June 21, 2004

By: 

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